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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jaffeson

Serial No. 78012977

Richard C. Jaffeson, pro se.

Dominic J. Ferraiuolo, Trademark Examining Attorney,
Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Seeherman, Kuhlke and Cataldo, Administrative
Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by Richard C. Jaffeson to register the mark NATIONAL WOMEN'S BASEBALL HALL OF FAME in standard character form on the Principal Register for "1. Annual Hall of Fame Inductions, 2. Annual MVP and Manager Awards, 3. Annual National Skills Championships, 4. Recognition stories and emblems, 5. Tournaments and special events, 6. library and historic archives, and 7. Related baseball memorabilia."¹

¹ Application Serial No. 78012977, filed June 16, 2000, based on applicant's allegation of a bona fide intent to use the mark in commerce.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as intended to be used in connection with applicant's goods and services, so resembles the following marks, previously registered in standard character form:

NATIONAL BASEBALL HALL OF FAME² for

"pewter figurines, key rings made of non-precious metal, metal bells,

decals, bumper stickers, posters, yearbooks, programs, newsletters, pen and pencil desk sets, pens, pencils, note pads and cases for note pads, stationery-namely, letter writing paper and envelopes, postcards, playing cards,

china plates, tea cups and saucers and pitchers, plates made of non-precious metal, pewter coasters, ceramic cups, trivets and figurines, ceramic and glass mugs and tankards, drinking glasses,

shirts, sweaters, jackets, pants, shorts, neckties, caps and scarves,

souvenir buttons and pins, belt buckles, and thimbels [sic];"

BASEBALL HALL OF FAME³ for "shirts;"

NATIONAL BASEBALL HALL OF FAME⁴ for "magnets and sunglasses" and "pennants;"

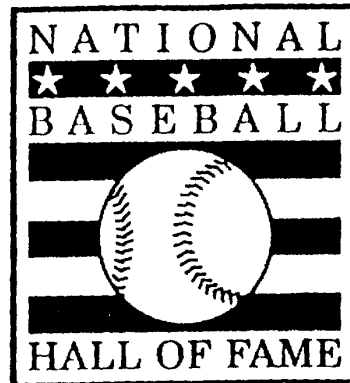
² Registration No. 1373410, issued December 3, 1985 with a disclaimer of "baseball" apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged, first renewal.

³ Registration No. 1361599, issued September 24, 1985 with a disclaimer of "baseball" apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged, first renewal.

NATIONAL BASEBALL HALL OF FAME AND MUSEUM⁵ for

"education and entertainment services, namely, services rendered in connection with the operation of a baseball museum and library, organizing and sponsoring annual baseball games and organizing and sponsoring annual baseball photograph contests;"

and the mark shown below⁶:



for

"educational and entertainment services, namely, services rendered in connection with the operation of a baseball museum and library; organizing and sponsoring annual baseball games; organizing and sponsoring annual baseball photograph contests; and conducting classes, seminars and workshops in the field of baseball, and distributing course materials in connection therewith,

mail order catalog services featuring bats, balls, games, glassware, ceramic ware, plates, framed artwork, plaques,

⁴ Registration No. 1392191, issued May 6, 1986 with a disclaimer of "baseball" apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged, first renewal.

⁵ Registration No. 1442473, issued June 19, 1987 with a claim of acquired distinctiveness under Trademark Act Section 2(f) and a disclaimer of "baseball" and "museum" apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁶ Registration No. 2191138, issued September 22, 1998 with a disclaimer of "baseball" and the design of a baseball apart from the mark as shown. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

photographs and prints, sculptures and figurines, chess sets, wooden boxes, Christmas ornaments, clothing, bags, luggage, team uniforms, jewelry, books, audio and video tapes, trading cards, postcards, posters, pens, pencils, magnets, key chains and other souvenir and novelty items;"

as to be likely to cause confusion.⁷ In addition, the trademark examining attorney required applicant to submit an acceptable amendment to his identification of goods and services.

When the refusal and requirement were made final, applicant appealed. Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

The examining attorney maintains that applicant's mark is nearly identical or highly similar to the marks in the cited registrations; that there are no limitations in the cited marks to include only men's baseball, to the exclusion of women's baseball; and that the addition of the term "WOMEN'S" to applicant's mark is insufficient to distinguish his mark from those of registrant. The examining attorney further argues that applicant's goods and services are broadly identified; and that, as a result, applicant's goods and services encompass many of the goods

⁷ The examining attorney also cited Registration No. 2147016 as a bar to registration under Section 2(d) of the Trademark Act. That registration subsequently was cancelled under Section 8 of the Act. Accordingly, applicant's appeal is moot with regard to that registration, and all arguments set forth by applicant and the examining attorney with regard thereto will be given no further consideration.

and services listed in the cited registrations. The examining attorney argues in addition that neither the involved application nor the cited registrations are limited as to channels of trade; and that, as a result, the goods and services recited therein are presumed to move in normal channels of trade, and are available to all potential customers. With regard to the requirement that applicant submit an acceptable amendment to the identification of goods and services, the examining attorney argues that the identification of goods and services, as filed, contains indefinite language; that the identification of goods and services was filed in a single International Class; that, however, the identification encompasses goods and services in several International Classes; that it is impossible to determine the number of classes of goods and services identified in the application due to the indefinite recitation thereof; and that applicant has failed to submit any amendment to his identification of goods and services.

Applicant contends that the primary service provided under the mark is the induction of women's players in regulation baseball into applicant's hall of fame, as well as making available "products bearing the organization's name with those of players who have received induction,

e.g. bats, buttons, caps, and t-shirts." (Applicant's brief p. 1) Applicant specifies that he offers induction only to women baseball players, whereas the services offered by registrant do not include induction of women. Applicant further notes that whereas registrant's services include a baseball museum, those of applicant do not. Applicant submitted with its brief a promotional flyer displaying the applied-for mark in connection with inductions from 1999 to 2004.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We begin by considering the similarities and dissimilarities between the marks in the application and

the cited registrations. The test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We note that applicant's mark, NATIONAL WOMEN'S BASEBALL HALL OF FAME, subsumes and incorporates in their entirety registrant's marks NATIONAL BASEBALL HALL OF FAME (Registration Nos. 1373410 and 1392191) and BASEBALL HALL OF FAME (Registration No. 1361599). Our primary reviewing court has held that the mere addition of a word to a registered mark does not eliminate the likelihood of confusion between marks that otherwise are nearly identical in sound, appearance, meaning and commercial impression. *See In re Chatam International Incorporated*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). In this case, we find that the addition of the term "WOMEN'S" to the marks in the above cited registrations fails to alter the commercial

impression of those marks so that confusion is unlikely. We further note that applicant's mark is highly similar to the cited mark NATIONAL BASEBALL HALL OF FAME AND MUSEUM (Registration No. 1442473). The two marks are identical as to the wording "NATIONAL" and "BASEBALL HALL OF FAME" and differ only in the addition of the word "WOMEN'S" to applicant's mark and "AND MUSEUM" to that of registrant. Thus, we find that the similarities in sound, appearance, meaning and commercial impression of the marks NATIONAL WOMEN'S BASEBALL HALL OF FAME and NATIONAL BASEBALL HALL OF FAME AND MUSEUM outweigh the dissimilarities so that confusion as to source is likely to result if used in connection with related goods and services.

We note in addition that applicant's NATIONAL WOMEN'S BASEBALL HALL OF FAME mark incorporates in its entirety the wording in the mark NATIONAL BASEBALL HALL OF FAME and stars and stripes design (Registration No. 2191138). As such, applicant's mark includes the word portion of the mark in this cited registration with the mere addition of the term "WOMEN'S". Thus, we find that applicant's mark is nearly identical to the word portion of the mark NATIONAL BASEBALL HALL OF FAME and stars and stripes design in sound, appearance, meaning and commercial impression. See *In re Chatam International Incorporated, supra*.

Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In this case, the dominant portion of the mark in Registration No. 2191138, that is to say, the portion that is most likely to be remembered by consumers, is the wording NATIONAL BASEBALL HALL OF FAME. As noted above, we find that the mere addition of the term "WOMEN'S" to applicant's mark fails to alter the commercial impression between the marks so that confusion is unlikely.

Therefore, when we compare the marks in their entireties to determine whether they are similar in sound, appearance, meaning and commercial impression, we conclude that the similarities between applicant's mark and the marks in the cited registrations far outweigh the dissimilarities.

Next, we consider whether the goods and services of the applicant and registrant are related. In making our determination, we look to the goods and services as identified in the involved application and cited registrations. *See Octocom Systems, Inc. v. Houston*

Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.")

Turning first to applicant's services, we find that applicant's "library and historic archives" are identical in part and otherwise closely related to "operation of a baseball museum and library" in Registration Nos. 1442473 and 2191138. We note applicant's argument that he does not provide museum services. However, regardless of the place or manner in which applicant stores his library and archival materials, his provision of library and archive services is nearly identical to the baseball library services recited in the above referenced registrations. We further find that applicant's broadly worded "annual national skills championships" and "tournaments and special

events" may include and otherwise are closely related to "organizing and sponsoring annual baseball games" in Registration Nos. 1442473 and 2191138 and "conducting classes, seminars and workshops in the field of baseball" in Registration No. 2191138. Turning to applicant's goods, we note that applicant asserts in his brief that "related baseball memorabilia" includes such items as "bats, buttons, caps, and t-shirts." (Applicant's brief, p. 1) Those goods are specifically identified, along with other goods that may be included within the broad category of "baseball memorabilia" in cited Registration Nos. 1373410 and 1361599. In addition, we note that applicant's baseball memorabilia typically includes such items as "pennants" identified in Registration No. 1392191. Furthermore, the items specified by applicant among his baseball memorabilia are offered by the "mail order services" featuring numerous goods including "souvenir and novelty items" in Registration No. 2191138. In short, applicant's broadly worded identification of goods and services encompasses many of the goods and services identified in the cited registrations. In addition, it

has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their

marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each [party's] goods or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

In this case, applicant and registrant both provide a wide variety of goods and services related to the game of baseball. We are not persuaded by applicant's argument that the focus of his goods and services solely upon women's baseball serves to obviate a likelihood of confusion between his goods and services and those in the cited registrations. First, the identification of goods and services in the involved application contains no such limitations. Thus, and as noted above, we must base our determination with regard to the relatedness of the parties' goods and services upon the identification of goods and services set forth in the application at issue. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, *supra*. Second, even in the event applicant's goods and services may be distinguished from those of registrant based upon the gender of the athletes recognized thereby, it does not necessarily relieve consumers from experiencing confusion as to the source or sponsorship of those goods

and services. As the Federal Circuit stated in *Recot, Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1895, 1898 (Fed. Cir. 2000), "Even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." See also *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.2d 1367, 63 USPQ2d 1303, 1309-10 (Fed Cir. 2002) ("Hence the products as described in the pertinent registrations are not the same. But they are related as required by *du Pont*."); and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services."). Further, inasmuch as the recitations of goods and services in the cited registrations are not limited to any specific channels of trade, we presume an overlap and that the goods and services would be offered in all ordinary trade channels for these goods and services and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them.

In light of the foregoing, we conclude that consumers familiar with registrant's goods and services sold under its above-referenced marks would be likely to believe, upon encountering applicant's goods and services rendered under the mark, NATIONAL WOMEN'S BASEBALL HALL OF FAME, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

We turn finally to the examining attorney's requirement that applicant submit an acceptable amendment to his identification of goods and services. In order to be eligible for registration, an application must specify the particular goods or services on or in connection with which the applicant uses, or has a bona fide intention to

use, the mark in commerce. See Sections 1(a)(2) and 1(b)(2) of the Trademark Act; 15 U.S.C. §§1051(a)(2) and 1051(b)(2). See also Trademark Rule 2.32(a)(6). The identification of goods or services must be specific, definite, clear, accurate and concise. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); and *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974). In addition, an application based upon Section 1(b) of the Trademark Act seeking registration of a mark for multiple classes of goods and services must contain the following: the class numbers for which registration is sought, and the goods or services appropriately classified in each class; and a filing fee for each class. See TMEP §1403.01 (4th ed. rev. 2005).

As noted above, applicant's identification of goods and services reads as follows: "1. Annual Hall of Fame Inductions, 2. Annual MVP and Manager Awards, 3. Annual National Skills Championships, 4. Recognition stories and emblems, 5. Tournaments and special events, 6. library and historic archives, and 7. Related baseball memorabilia." Clearly, applicant's recitation identifies both goods

("baseball memorabilia") as well as activities that appear to be services ("annual hall of fame inductions," "annual national skills championships," tournaments and special events," and "library and historic archives"). In addition, "annual MVP and manager awards," and "recognition stories and emblems" may identify either goods or services. In all cases, the goods and/or services are indefinitely recited in the application and unclear as to their specific nature as well as International Classification. For instance, "baseball memorabilia" may include a wide variety of goods that may be classified in numerous International Classes. We further note that applicant submitted a filing fee with his application sufficient for a single International Class of goods or services. Finally, the record in this case indicates that the examining attorney explained the shortcomings of applicant's identification of goods and services in his first and final Office actions as well as in his denial of applicant's request for reconsideration of the matters now on appeal. The record further indicates that applicant failed to submit either an amendment to his identification of goods or services or additional filing fees for each class of goods and services

identified in his application.⁸

We find, therefore, that the identification of goods and services submitted by applicant with his involved application is unacceptable; and that, in addition, applicant failed to submit either an amended identification of goods and services or additional filing fees for each class of goods and services recited in his application.

Decision: The examining attorney's refusal to register applicant's mark is affirmed on both grounds.

⁸ Applicant's requests for additional information, *inter alia*, with regard to submitting an amendment to his identification of goods and services was addressed by the examining attorney in his May 13, 2005 denial of applicant's request for reconsideration as well as in an order issued on March 15, 2005 by one of the above Administrative Trademark Judges.